

- 2 -

The following principle of law applies to all sec. 103 rejections. MPEP 2143.03 provides "To establish prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." [emphasis added] That is, to have any expectation of rejecting the claims over a single reference or a combination of references, each limitation must be taught somewhere in the applied prior art. If limitations are not found in any of the applied prior art, the rejection cannot stand. In this case, the applied prior art references clearly do not arguably teach some limitations of the claims.

Applicant agrees that Hunt does not teach "an extrusion rod having a diameter of from about 0.2 inch to about 0.5 inch, the extrusion rod having at least about 12 grains in the cross section of the extrusion rod" (claim 1) and does not teach "the extrusion rod having at least about 12 grains in the 1/4 inch diameter cross section of the extrusion rod" (claim 9).

King also has no teaching of these limitations. King teaches a cast rod, and has no teaching that the cast rod is an extrusion rod that is thereafter reduced in diameter by extrusion. King mentions extrusion at only one location, col. 1, line 34, and that is in the context of alloys that are first produced in powder (not cast) form, and then extruded.

The explanation of the rejection represents that King teaches "an extrusion rod", see last line of page 2 of the Office Action. No location of support in King for this assertion King is set forth in the Office Action, and Applicant can find no such teaching. Applicant asks that the Examiner set forth the precise location in King where there is a teaching that King's material is cast and then extruded.

The present Specification carefully explains the importance of this limitation in a material that is first cast and extruded to make welding filler metal, see for example paragraphs [0009] and [0021]-[0022]. The whole point of the limitation on the number of grains in the cast rod is to achieve a particular result in the next extrusion step. Because the cast rod of King is not extruded, there is no relevance of any teaching of

- 3 -

King regarding grains.

Applicant can find no teaching of the limitations of dependent claims 2-5 and 10-11 in either reference. If the rejections of these claims are maintained, Applicant asks that the locations of the teachings of these claims in the references be identified with particularity. Regarding the third full paragraph on page 3 of the Office Action, the cited case authority is not applicable because there is no teaching of the present process in the applied references for the reasons stated above.

The present rejection seeks to perform a hindsight reconstruction based upon unrelated references, which is technically unsupported and is legally improper. The case authority and the MPEP provide guidance on this point. The present rejection is a sec. 103 combination rejection. It is well established that a proper sec. 103 combination rejection requires more than just finding in the references the elements recited in the claim (but which was not done here). To reach a proper teaching of an article or process through a combination of references, there must be stated an objective motivation to combine the teachings of the references, not a hindsight rationalization in light of the disclosure of the specification being examined. MPEP 2143 and 2143.01. See also, for example, In re Fine, 5 USPQ2d 1596, 1598 (at headnote 1) (Fed.Cir. 1988), In re Laskowski, 10 USPQ2d 1397, 1398 (Fed.Cir. 1989), W.L. Gore & Associates v. Garlock, Inc., 220 USPQ 303, 311-313 (Fed. Cir., 1983), and Ex parte Levengood, 28 USPQ2d 1300 (Board of Appeals and Interferences, 1993); Ex parte Chicago Rawhide Manufacturing Co., 223 USPQ 351 (Board of Appeals 1984). As stated in In re Fine at 5 USPQ2d 1598:

"The PTO has the burden under section 103 to establish a prima facie case of obviousness. [citation omitted] It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

And, at 5 USPQ2d 1600:

- 4 -

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Following this authority, the MPEP states that the examiner must provide such an objective basis for combining the teachings of the applied prior art. In constructing such rejections, MPEP 2143.01 provides specific instructions as to what must be shown in order to extract specific teachings from the individual references:

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

* * * * *

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)."

* * * * *

"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd.Pat.App.& Inter. 1993)."

- 5 -

Here, there is set forth no objective basis for combining the teachings of the references in the manner used by this rejection, and selecting the helpful portions from each reference while ignoring the unhelpful portions. An objective basis is one set forth in the art or which can be established by a declaration, not one that can be developed in light of the present disclosure. The rationale urged in the explanation of the rejection, increasing malleability of the rod to endure the moderate bending imposed by automatic welding wire feeders, has nothing to do with the recited extrusion process. The present claims do not recite malleability, but instead recite extrusion. If the rejection is maintained, Applicant asks that the Examiner set forth the objective basis found in the references themselves for combining the teachings of the references.

Applicant asks that the Examiner reconsider and withdraw this ground of rejection.

Applicant submits that the application is in condition for allowance, and requests such allowance.

I hereby certify that this paper (5 pages total) is being facsimile transmitted to the Patent and Trademark Office at fax 703-872-9302 on February 17, 2003.

Respectfully submitted,

Gregory O. Garmong

Reg. No. 29,382

Attorney for Applicant